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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,872	11/28/2001	Tsunehiro Tsukada	35.G2941	9796

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

HANG, VU B

ART UNIT	PAPER NUMBER
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2625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/994,872

Applicant(s)

TSUKADA, TSUNEHIO

Examiner

Vu B. Hang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/28/2005.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

- This office action is responsive to the following communication: a Request for Continued Examination filed on 11/22/2006.
- The amendments for Claims 1, 6, 11, 21 and 26, received on 11/22/2006, have been entered and made of record.
- Claims 1-30 are pending in the application.

Response to Arguments

1. Applicant's arguments filed on 11/22/2006, with respect to the rejections of Claims 1, 6, 11, 21 and 26 under 35 U.S.C. 103(a) as being unpatentable over Rasansky et al. (US Patent 5,960,406) in view of Vidyanand (US Patent 6,330,071 B1), have been fully considered and are persuasive. Therefore, the previous rejections have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Clough et al. (US Patent 6,788,429 B1).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6-9 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rasansky et al. (US Patent 5,960,406) in view of Clough et al. (US Patent 6,788,429 B1).

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4. Regarding **Claims 1, 6, and 11**, Rasansky discloses an information processing apparatus (see Fig. 9, Col.1, Line 54-65 and Col.8, line 7-16), comprising:

a receiving unit adapted to receive a request from an external apparatus (see Fig.1A (10), Col.4, Line 44-46 and Col.5, Line 1-8);

a generation unit adapted to generate, in response to a received request from the external apparatus, print data corresponding to a preview displayed on a display screen on the external apparatus (see Fig.7 (950), Col.2, Line 8-13 and Col.8, Line 7-16); and

an obtaining unit adapted to obtain instructions for printing via the display screen on the external apparatus (see Fig.7, Col.2, Line 8-13 and Col.8, Line 7-16).

Rasansky fails disclose a selecting unit adapted to select a print server to transmit the generated print data, and a transmission control unit adapted to control transmission so that the print data is transmitted to the selected print server. Rasansky, however, teaches the network communications between end users at client workstations (see Col.5, Line 22-27), requesting a printing operation from a workstation (see Col.5, line 1-8) and the use of communication servers for data manipulation and communication (see Fig.1A (10) and Col.5, Line 41-44). Clough discloses a selecting unit adapted to select a print server (see Fig.1 and Col.3, Line 45-52), wherein the print server is selected in accordance with an external apparatus (see Fig.1 (12) and Col.3, Line 20-30); and a transmission control unit adapted to control the transmission of print data to the selected print server in response to instructions for printing (see Fig.2 (14,26), Col.3, Line 20-30, Col.4, Line 30-37).

Rasansky and Clough are combinable because they are from the same field of endeavor, namely network information processing systems. At the time of the invention, it would have

been obvious for one skilled in the art to include to the apparatus a selecting unit adapted to select a print server to transmit the generated print data, and a transmission control unit to control the transmission of print data to the selected print server in response to instructions for printing. The motivation would be to allow for the end users at the external workstations to select the best available printers across the network to perform customized printing operations. Since the printers in a network environment are likely to have different capabilities, it would be necessary to select the best available printer for printing a specific print data. In a multiple server environment, it could also be necessary to select the best available printer nearest to the workstation that is requesting the print operation.

5. Regarding **Claims 2, 7 and 12**, Rasansky further discloses a specification unit adapted to specify a template for generating the print data and data to be inserted into the template (see Fig.2B and Fig.3 (480,500,520)), wherein the generation unit generates the print data based on the template and the data specified by the specification unit (see Fig.7 (950), Col.2, Line 8-13 and Col.8, Line 7-16).

6. Regarding **Claims 3, 8 and 13**, Rasansky further discloses the display screen comprises a display screen displayed on web browser (see Col.5, Line 20-27), and the request from the external apparatus is communicated between the web browser and the external apparatus and a web server (see Col.5, Line 1-8 and Col.5, Line 41-44).

7. Regarding **Claims 4, 9 and 14**, Clough further discloses a determination unit adapted to determine, when the print server can transmit data to a plurality of printers, which printer is to be use to perform printing by analyzing the request from an external apparatus (see Fig.2 (42,44) and Col.4, Line 30-37), and wherein the transmission control unit controls the transmission of

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print data and information designating the printer (see Fig.2 (14,26), Col.3, Line 20-30, Col.4, Line 30-37).

8. Claims 5, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rasansky et al. (US Patent 5,960,406) in view of Clough et al. (US Patent 6,788,429 B1), and in further view of Levine et al. (US Patent 6,020,973).

9. Regarding **Claims 5, 10 and 15**, Rasansky and Clough disclose the information processing apparatus of Claim 1 above but fail to disclose an obtaining unit adapted to obtain the status information on the plurality of printers and a selection control unit to prohibit the selection of unusable printers. Levine, however, discloses an obtaining unit adapted to obtain, when the printer can transmit to plurality of printers, status information on a plurality of printers (see Fig.5 (208) and Col.11, Line 1-8) and a selection control unit to select a plurality of printers (see Col.5, line 26-29).

Rasansky, Clough and Levine are combinable because they from the same field of endeavor, namely variable data print processing apparatuses. At the time of the invention, it would have been obvious for one skilled in the art to include to the selection control unit a means for prohibiting the selection of unusable printers in the apparatus based on the obtained status information. The motivation for doing so would be to ensure that the best available printers in the apparatus are selected to carry out the printing operations in accordance to the print data.

10. **Claims 21-25** recite identical features as Claims 1-5 except Claim 21-25 are in a form of a computer readable recording medium. Thus, arguments similar to that presented above for Claims 1-5 are equally applicable to Claim 21-25 because without a computer readable recording

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medium to store a program that makes it possible for the apparatus to operate, the apparatus described in Claims 1-5 could not function.

11. **Claims 26-30** recite identical features as Claims 1-5 except Claim 26-30 are in a form of a computer-executable program stored on a computer readable medium. Thus, arguments similar to that presented above for Claims 1-5 are equally applicable to Claim 26-30 because without a computer-executable program stored on a computer readable recording medium that makes it possible for the apparatus to operate, the apparatus described in Claims 1-5 could not function.

Conclusion


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu B. Hang whose telephone number is (571) 272-0582. The examiner can normally be reached on Monday-Friday, 9:00am - 6:00pm.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vu Hang
Assistant Examiner



TWYLER LAMB
SUPERVISORY PATENT EXAMINER